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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,278	11/10/1999	WILLIAM J. DONOVAN	33-99-001	7771

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EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/437,278

Applicant(s)

DONOVAN ET AL.

Examiner

Rachel L. Porter

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--Th MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED October 29, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See continuation sheet attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 1-23.

Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Continuation of 2. NOTE: The new limitations of claims 21-23 (the format of the second new reservation differs from . . . the format of the old reservation data in the data store) requires new search and/or consideration. See attached continuation sheet..

Continuation of Advisory Action

Continuation of item # 2

The amendments filed on 10/29/02 will not be entered at this time. However, if submitted separately, the Applicant's response to the specification objection under 35 U.S.C. 132 and the 112, 1st paragraph rejections of claims 1-4, 6-11, and 13-23 will be entered and the corresponding objection and rejections will be withdrawn.

Continuation of item #5

Applicant's arguments filed 10/29/02 have been fully considered but they are not persuasive.

(A) On page 10 of the response the Applicant argues that rejection of claim 1 is improper because the primary reference (Dettelbach et al) teaches away from the modification applied in the rejection (i.e. the combination with Johnson et al).

In response, the Examiner maintains that it is, in fact, unclear whether the Dettelbach system accommodates files of different formats in the same data store. The Examiner is unable to find anything in the reference that precludes or "teaches away from" an ability to accommodate multiple file formats. The Applicant relies on the system's conversion of files to .XFR files to support the assertion that only one format can be accommodated in a data store. However, sections of Dettelbach suggest that a plurality of data formats is included, even among the transfer files. (See Dettelbach col. 4, lines 53-58; col. 4, lines 60-col. 6, lines 15). The various types of records included among the reservation data each have different formats.

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Furthermore, the Examiner submits that the Dettelbach reference does not teach away from the applied combination of references or the Applicant's invention.

Dettelbach suggests several advantages that the invention is intended to provide for users, including the ability to efficiently receive and interpret pre-travel data in a logical and efficient manner. (col. 2, lines 40-51) Contrary to the Applicant's assertion, the proposed modification applied in the rejection of claim 1 does not render the disclosed invention unsatisfactory for the intended purpose(s) summarized by the cited passage of Dettelbach. The ability to accommodate multiple formats would not necessarily preclude users from receiving and interpreting pre-travel data in a logical and efficient manner.

Moreover, when considering and applying prior art to claim limitations, alternate embodiments may be considered. According to MPEP §2123, "a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments." *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) Dettelbach discloses that "[a]ccording to a *more limited aspect of the invention*, the system includes a plurality of files . . . A means for inputting the pre-travel data from one or more customer airline computer reservation systems and into a raw data file is provided, another control means converts the raw data file into machine readable transfer file suitable for input by the single common relational database control." [*Emphasis added.*] (col. 2, lines 30-35) The Examiner

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interprets this phrasing to mean the aspects disclosed and summarized in the passage are parts of a limited or preferred embodiment that does not preclude other possible embodiments that have alternate configurations that still provide the disclosed advantages of the Dettelbach system (col. 2, lines 40-51)

(B) On page 12 of the response filed 10/29/02, the Applicant argues that the combination of Dettelbach in view of Johnson applied to claim 1 is improper because there is no motivation to combine the references or to make the proposed modification.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references.

In the present case, Dettelbach suggests several advantages that the invention is intended to provide for users, including the ability to efficiently retrieve and interpret pre-travel data in a logical and efficient manner. (col. 2, lines 40-51) The Examiner submits that the proposed modification applied in the rejection of claim 1 does not

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render the disclosed invention unsatisfactory for the intended purpose(s) summarized by the cited passage of Dettelbach.

Moreover, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The mandate of numerous court decisions support the position given above. For instance, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that: (i) obviousness does not require absolute predictability; (ii) non-preferred embodiments of prior art must also be considered; and (iii) the question is not express teaching of references, but what they would suggest. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

Using these standards, the Examiner respectfully submits that she has presented evidence of corresponding claim elements in the prior art by expressly pointing to specific portions of each applied reference. Furthermore, the Examiner has expressly articulated combinations and motivations for the combinations as well as scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest the Applicant's claimed invention and that support a holding of obviousness in the present Office Action as well as the prior Office Actions. The applied combination of references in the rejection of claim 1 is proper, and the rejection is maintained.

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(C) On page 14 of the response, the Applicant argues that the newly added limitation "wherein the format of the second new reservation data in the data store differs from . . . the format of the old reservation data in the data store" are non-obvious over the art of record.

These limitations will not be addressed on merit because the newly claimed features have not been entered as of the present communication.